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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,371	09/04/2003	Susann Marie Keohane	AUS920030641US1	8434
35525	7590	04/17/2009		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER NAJEE-ULLAH, TARIQ S	
			ART UNIT 2456	PAPER NUMBER
			NOTIFICATION DATE 04/17/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/655,371	<b>Applicant(s)</b> KEOHANE ET AL.	
	<b>Examiner</b> TARIQ S. NAJEE-ULLAH	<b>Art Unit</b> 2456	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 15-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 30, 2009 has been entered.

### ***Response to Amendment***

2. This Office action has been issued in response to the Applicant's Amendment filed January 30, 2009. Claims 1 and 15-28 are pending in the application. Claim 1 has been amended. Claims 15-28 have been added.

### ***Response to Arguments***

3. Applicant's arguments with respect to the prior art rejection of claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 and 15-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2005/0021636 to Kumar in view of US Patent

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Application Publication 2002/0091777 to Schwartz and further in view of US  
2004/0186895 to Ellis.

Regarding claims 1, 19 and 24, Kumar teaches, **a method, system or computer program product for selectively generating automatic notifications that a user is away** (Kumar, pg. 1, par. 9; a method, apparatus and system for enabling email users to configure automated responses tailored to the various types of incoming email messages), **comprising: responsive to receiving an email message at an email address of the user** (Kumar, pg. 1, par. 12; the email user may specify different automated responses for different types of incoming email messages from a variety of email addresses), **determining whether an email address of a sender of the email message is an email address in a set of determined email addresses** (Kumar, pg. 1-2, par. 12-14; the email user may specify different automated responses for different types of email addresses, i.e. a determined set of email addresses that are internal to the network, external to the network, of a specific domain, or other type specified by the user); **responsive to a determination that the email address of the sender is an email address in the set of determined email addresses, sending an away notification to the email address of the sender** (Kumar, pg. 1-2, par. 12-14; the email user may specify different automated responses for different types of email addresses, i.e. a determined set of email addresses that are internal to the network, external to the network, of a specific domain, or other type specified by the user; pg. 2, par. 17-18; Upon receipt of an incoming email message, the recipient's email configuration may be examined to determine whether an automatic response is warranted, i.e. whether an

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automatic response should be sent or not, fig. 4, 402); **responsive to a determination that the email address of the sender is not an email address in the list of determined email addresses, not sending an away notification to the email address of the sender** (Kumar, pg. 2, par. 17-18; Upon receipt of an incoming email message, the recipient's email configuration may be examined to determine whether an automatic response is warranted, i.e. whether an automatic response should be sent or not, fig. 4, 402).

While Kumar teaches determining whether the incoming email address is in a determined set of email address, Kumar does not explicitly teach that set of addresses being further sorted or associated with a certain time period or date uniquely associated with each email in that set of addresses. Schwartz teaches a configurable time period (Schwartz, pg. 2, par. 12, 14). Specifically, Schwartz teaches **wherein the set of determined email addresses comprises email addresses of recipients to which email messages have been previously sent within a configurable time period that is uniquely associated with each email address in the set of determined email addresses** (Schwartz, pg. 2, par. 12, 14; one or more reply messages and files may be forwarded for receipt by selected senders in accordance with suitable predetermined criteria such as, for example, date, time, day of week, number of e-mail messages sent to the recipient, number of e-mail messages sent to the recipient by a specific sender, the date the recipient last retrieved e-mail, the time the recipient last retrieved e-mail, the date the recipient last received e-mail from a specific sender, or the date the recipient last sent e-mail to a specific sender), **wherein the set of determined email**

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**addresses and a date associated with each email address in the set of determined email addresses is stored in a data structure** (Schwartz, pg. 2, par. 12, 14; one or more reply messages and files may be forwarded for receipt by selected senders in accordance with suitable predetermined criteria such as, for example, the date the recipient last retrieved e-mail, the date the recipient last received e-mail from a specific sender, or the date the recipient last sent e-mail to a specific sender; par. 15, message server stores reply message on in a file, i.e. data structure; par. 21 data stored in a lookup table or database), **and wherein the date associated with each email address in the set of determined email addresses is a date an email message was sent to the associated email address from the email address of the user**

(Schwartz, pg. 2, par. 12, 14; one or more reply messages and files may be forwarded for receipt by selected senders in accordance with suitable predetermined criteria such as, for example, the date the recipient last sent e-mail to a specific sender);

**determining whether the date associated with the email address in the set of determined email addresses is within the configurable time period that is**

**uniquely associated with the email address** (Schwartz, pg. 2, par. 12, 14; one or more reply messages and files may be forwarded for receipt by selected senders in accordance with suitable predetermined criteria such as, for example, date, time, day of week, number of e-mail messages sent to the recipient by a specific sender, i.e. email address).

To provide the method of Kumar with additional functionality to sort a set of email address stored in a data structure based on dates and a user configurable time period

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associated with the individual email addresses in the set would have been obvious to one of ordinary skill in the art, in view of the teachings of Schwartz, since all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention, i.e., one skilled in the art would have recognized it will be readily apparent to those of ordinary skill in the art that the internal and/or external set of recipients of Kumar could have been further divided into different types including the configurable time period of Schwartz.

Kumar-Schwartz does not explicitly teach the adding or removal of email address determined to be part of the set of email address within a configurable time period. Ellis teaches **responsive to a determination that the date is within the configurable time period, retaining the email address in the set of determined email addresses** (Ellis, pg. 5, par. 44); **and responsive to a determination that the date is not within the configurable time period, removing the email address from the set of determined email addresses** (Ellis, pg. 4-5, par. 40-44). To provide the method of Kumar-Schwartz with additional functionality to add or remove an email address to or from a set of email address based on dates and a user configurable time period associated with the individual email addresses in the set would have been obvious to one of ordinary skill in the art, in view of the teachings of Ellis, since all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the

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combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention.

Regarding claims 15, 20, and 25, Kumar-Schwartz-Ellis discloses the invention substantially as described in claims 1, 19 and 24 above including, **further comprising: responsive to sending an outgoing email message at the email address of the user, identifying a first recipient email address** (Ellis, pg. 4-5, par. 40-44); **and determining whether the first recipient email address is located in the set of determined email addresses** (Ellis, pg. 4-5, par. 40-44).

Regarding claims 16, 21 and 26, Kumar-Schwartz-Ellis discloses the invention substantially as described in claims 15, 20 and 25 above including, **further comprising: responsive to a determination that the first recipient email address is not located in the set of determined email addresses, storing the first recipient email address in the set of determined email addresses** (Ellis, pg. 4-5, par. 40-44).

Regarding claims 17, 22 and 27, Kumar-Schwartz-Ellis discloses the invention substantially as described in claims 16, 21 and 26 above including, **further comprising: determining whether additional recipient email addresses are present in the outgoing email message** (Ellis, pg. 4-5, par. 40-44); **and responsive to the determination that additional recipient email addresses are present, determining whether the additional recipient email addresses are located in the set of determined email addresses** (Ellis, pg. 4-5, par. 40-44).



Regarding claims 18, 23 and 28, Kumar-Schwartz-Ellis discloses the invention substantially as described in claims 15, 20 and 25 above including, **further comprising: responsive to a determination that the first recipient email address is located in the set of determined email addresses** (Ellis, pg. 4-5, par. 40-44), **updating the date associated with the first recipient email address in the set of determined email addresses** (Ellis, pg. 4-5, par. 40-44).

### ***Conclusion***

6. In conclusion, in an effort to better place the claims in condition for allowance, Examiner encourages the modification of claim language to include language that is more precisely descriptive and provides a more clear representation of what the Applicant presents as the invention in the specification in a manner which overcomes the prior art as presented. Examiner also reminds Applicant that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TARIQ S. NAJEE-ULLAH whose telephone number is (571)270-5013. The examiner can normally be reached on Monday through Friday 8:30 - 6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

T. N.

/Yasin M Barqadle/

Primary Examiner, Art Unit 2456